

In The United States Patent And Trademark Office

Applicant: Heikki Vatanen et al. Date: March 9, 2010
Date Filed: September 20, 2006 Docket No.: LEITZI-2
App. No.: 10/598,181 Art Unit: 1792
For: Method for Coating a Examiner: N. Empie
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RESPONSE AFTER FINAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office action dated Feb. 16, 2010, please consider the following Remarks. The Commissioner is hereby authorized to charge any additional fees that may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 50-2663.

Remarks

Claims 11, and 13–23 remain pending in the application. In the Office action dated February 14, 2010 claims 19, 21, and 22 were rejected as obvious over *Nakamura* in view of *Arai*, *Chino*, and *Kondo*. Claim 20 was rejected as obvious over *Nakamura* in view of *Arai*, *Chino*, and *Kondo* and further in view of *Kustermann*. Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Nakamura* in view of *Arai*, *Chino*, and *Kondo* and further in view of *Yapel*. Claims 11, 14, 15, 17 and 18 were rejected as obvious over *Nakamura* et al in view of *Arai*, *Chino*, *Okada*, and *Kondo*.

The courtesy extended to applicant's counsel by Examiner Nathan Empie and Supervisory Examiner Michael Cleveland in the telephone interview conducted Mar. 8, 2010, is acknowledged with appreciation. During the interview *Nakamura* et al., *Arai*, Japanese publication JP 07.2045661 and *Okada* were discussed. During the interview applicant argued that the examiner's *prima facie* obviousness case was deficient because although *Nakamura* et al. discloses a device *capable* of cross machine profile measurements of a plurality of

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superpositioned layers of coating material along the flow plane; and *Arai*, and *JP 07.2045661* shows cross machine direction measurement and profiling of a single layer curtain coater; the combination of the references of the prior art does not show a known method for combining multiple devices such as shown in *Arai*, and *JP 07.2045661*, with the device of *Nakamura*.

Examiner Cleveland maintained that, given the necessary measurement capability of *Nakamura*, combining a number of the structures from *Arai*, was simply a matter of geometric rearrangement.

Applicant further argued that the art of record shows various developments in coater technology, with *Nakamura* showing measuring the thickness of each layer of a multilayer coating, and controlling the thickness of each layer, but not its cross machine direction profile; and that references *Arai*, and *JP 07.204566* showing measuring, and controlling the cross machine direction profile of a single layer curtain coating, but not the claimed measuring and controlling each layer of a multi-layer curtain coating. Applicant's claimed invention is a significant step in the development of the art i.e., it has a greater functionality, which, even if the prior art suggests that such functionality is desirable, the *how* by which the functionality may be achieved is not present in the prior art. And the mere possibility that the geometry of *Arai* could be manipulated to achieve a device capable of performing the claimed method is not sufficient for a *prima facie* case. In particular under MPEP 2143 (A)(2) the examiner has not made "a finding that *one of ordinary skill in the art could have combined the elements as claimed by known methods*" where "the known methods" proposed by the examiner are "geometric manipulations" which amounts to the invention of whole new structures and ways of combining them.

Agreement was not reached.